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Application Number 09/717,784

Filing Date November 21, 2000

First Named Inventor Heli Heiskari

Art Unit 2174

Examiner Name Lev Nguyen

Attorney Docket Number 944-003.041

**ENCLOSURES (Check all that apply)**

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Firm Name	Ware, Fressola, Van Der Sluys & Adolphson, LLP		
Signature			
Printed name	Anatoly Frenkel		
Date	November 21, 2005	Reg. No.	54,106

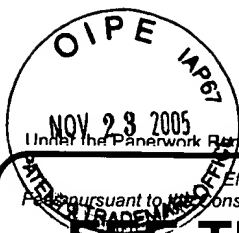
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**FEE TRANSMITTAL**  
**For FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$)**Complete if Known**

Application Number	09/717,784
Filing Date	November 21, 2000
First Named Inventor	Heli Heiskari
Examiner Name	Lev Nguyen
Art Unit	2174
Attorney Docket No.	944-003.041

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Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>	<b>Multiple Dependent Claims</b>
_____ - 20 or HP = _____	x _____	= _____		<b>Fee (\$)</b> <b>Fee Paid (\$)</b>

HP = highest number of total claims paid for, if greater than 20.

<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
_____ - 3 or HP = _____	x _____	= _____	

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

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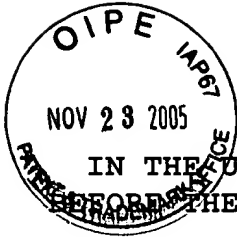
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**SUBMITTED BY**

Signature	<u>A. Frenkel</u>	Registration No. (Attorney/Agent)	54,106	Telephone	203-261-1234
Name (Print/Type)	Anatoly Frenkel	Date	November 21, 2005		

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Att. Docket 944-003.041

Serial No. 09/717,784

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re application of :  
Heli Heiskari :  
Serial No. 09/717,784 : Examiner: Lev Nguyen  
Filed: November 21, 2000 : Group Art Unit: 2174  
For: THREE-DIMENSIONAL ICONS FOR  
GRAPHICAL USER INTERFACE

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### BRIEF OF THE APPELLANTS

(37 CFR 1.192)

Sir:

This is an appeal from an Office Action mailed August 10, 2005, made final, in response to which a Notice of Appeal was filed on September 29, 2005. This appeal brief is being filed within two months of the filing of the Notice of Appeal.

11/25/2005 DTESSEM1 00000048 09717784

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Marie E. Forte

Dated: November 21, 2005

For all of the reasons discussed below, it is the belief of the undersigned that the claims of the application do distinguish the invention from the art relied on by the Examiner. Nevertheless, the undersigned is always willing to discuss possible amendments to any claims to clarify or resolve any issues related to claim interpretation that may remain after the Examiner has reviewed Appellant's brief. The Examiner is strongly encouraged to call the undersigned to discuss making any such amendments.

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I. THE REAL PARTY IN INTEREST

The real party in interest is Nokia Corporation, having a principal place of business in Espoo, Finland.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences which are currently under consideration. The appeal brief in the present patent application filed on May 27, 2004 was automatically withdrawn due to filing a Request for Continued Examination (RCE) filed on November 19, 2005. The claim Amendment submitted with the RCE was intended to fully describe the scope of the present invention.

III. STATUS OF CLAIMS

Per the final Office action mailed August 10, 2005, claims 1-15 are rejected. Claims 1-15 are pending and are being appealed.

IV. STATUS OF AMENDMENTS

No amendments have been filed since the mailing of the final Office action.

V. SUMMARY OF THE INVENTION

An object of the present invention is to make possible the presentation of low-resolution images with strong three-dimensional effect. A strong three-dimensional icon is created for low-resolution displays such as used in portable communication devices by alternating light and dark stripes, with some stripes changing from light to dark and optionally back to light to indicate a shadow, and other stripes from dark to light and optionally back to dark to indicate a highlight. Altogether, the light and dark stripes with shadows and

highlights provide the icon with a strong three-dimensional appearance.

According to a first aspect of the invention recited in claim 1, a computer-readable medium encoded with a data structure for use in providing a graphical icon as shown in Figures 1, 2A, 2B, 2C, 2D, 2E and 2F for display on a display of a portable communications device is characterized in that said data structure is encoded as digital data indicative of said graphical icon defined by alternating light and dark stripes, that a selected stripe of the light and dark stripes changes from light to dark and remains dark in a region bordering on at least a part of a dark segment of a neighbouring stripe, and beyond the dark segment the selected stripe remains dark or changes back to light to create a shadow adjacent to an edge of the icon, and a further selected stripe of said light and dark stripes changes from dark to light and remains light in a region bordering on at least a part of a light segment in the neighbouring stripe or in a further neighbouring stripe, and beyond the light segment the selected stripe remains light or changes back to dark to create a highlight adjacent to the edge or another edge of the icon, and that altogether the light and dark stripes with shadows and highlights provide the icon with a three-dimensional appearance.

According to a second aspect recited in claim 5 of the invention, a communication device shown in Figure 3 comprises means responsive to an event in the communication device for providing an event signal, a computer readable medium encoded with a data structure for use in providing a graphical icon for display on a display of a portable communications device, wherein the data structure is encoded as digital data indicative of said graphical icon defined by alternating light and dark stripes, wherein a selected stripe of the light and dark stripes changes from light to dark and remains dark in a region

bordering on at least a part of a dark segment of a neighbouring stripe, and beyond the dark segment the selected stripe remains dark or changes back to light to create a shadow adjacent to an edge of the icon, and a further selected stripe of said light and dark stripes changes from dark to light and remains light in a region bordering on at least a part of a light segment in the neighbouring stripe or in a further neighbouring stripe, and beyond the light segment the selected stripe remains light or changes back to dark to create a highlight adjacent to the edge or another edge of the icon, and that altogether the light and dark stripes with shadows and highlights provide the icon with a three-dimensional appearance, and means responsive to the event signal for retrieving the digital data from the computer-readable medium and causing said display of said graphical icon on said display according to said retrieved digital data.

According to a third aspect recited in claim 9 of the invention, a method, described by a flow chart of Figure 4, of displaying an icon on a portable communication device comprises the steps of retrieving, in response to an event signal, digital data from a computer-readable medium, and displaying said icon in response to said digital data retrieved from said computer-readable medium, wherein said digital data is indicative of said icon defined by alternating light and dark stripes, that a selected stripe of the light and dark stripes changes from light to dark and remains dark in a region bordering on at least a part of a dark segment of a neighbouring stripe, and beyond the dark segment the selected stripe remains dark or changes back to light to create a shadow adjacent to an edge of the icon, and a further selected stripe of said light and dark stripes changes from dark to light and remains light in a region bordering on at least a part of a light segment in the neighbouring stripe or in a further neighbouring stripe, and beyond the light segment the selected stripe remains light or changes back to dark to create



a highlight adjacent to the edge or another edge of the icon, and that altogether the light and dark stripes with shadows and highlights provide the icon with a three-dimensional appearance.

Further according to the first, second and third aspects of the invention, the digital data may be encoded according to a portable bitmap file format.

Still further according to the first, second and third aspects of the invention, the digital data may be encoded according to a portable graymap file format.

Further still according to the first, second and third aspects of the invention, the digital data may be encoded according to a portable color image file format.

Yet further according to the first, second and third aspects of the invention the alternating light and dark stripes may be vertical.

## VI. ISSUES

The following issues will be addressed in the argument:

- i) whether Smith et al. (US Patent No. 5,923,327) in view of Screen Dumps of Microsoft Excel 2000 ("MS Excel") renders the invention defined by claims 1, 2, 5, 6, 9, 10, and 13-15 obvious under 35 U.S.C. 103(a); and
- ii) whether Smith et al. (US Patent No. 5,923,327) in view of Screen Dumps of Microsoft Excel 2000 ("MS Excel") as applied to claims 1, 5 and 9 respectively, and further in view of Hess et al. (US Patent No. 6,415,320) renders the invention defined by claims 3-4, 7-8 and 11-12 obvious under 35 U.S.C. 103(a).

## VII. GROUPING OF THE CLAIMS

Independent claims 1, 5 and 9 are argued separately. Dependent claims 2 and 13, which depend on claim 1, dependent claims 6 and 14, which depend on claim 5, and dependent claims

10 and 15, which depend on claim 9, stand or fall with claims 1, 5 and 9, respectively.

Claims 3-4, 7-8 and 11-12 are dependent claims of independent claims 1, 5 or 9, respectively, but include significant further limitations compared to claims 1, 5 and 9 as described below, and so is believed separately patentable.

#### VIII. ARGUMENT

##### A. CLAIM 1 IS NOT OBVIOUS UNDER 35 USC SECTION 103(a)

Claim 1 is rejected under 35 USC 103(a) as being unpatentable over Smith et al. (US Patent No. 5,923,327) in view of Screen Dumps of Microsoft Excel 2000 ("MS Excel") on page 2 of the Final Office Action mailed on August 10, 2005.

The Examiner states that, in Figure 10 and in column 7, lines 43 through col. 8, line 10, col. 10, lines 64-67, Smith et al. teach "a computer-readable medium encoded with a data structure for use in providing a graphical icon for display on display of a portable communication device, characterized in that said data structure is encoded as digital data indicative of said graphical icon defined by alternating light and dark stripes, that selected stripes of said light and dark stripes change from light to dark and back to light to indicate a shadow adjacent an edge of said icon and from dark to light and back to dark to indicate a highlight adjacent another edge of said icon, and that altogether said light and dark stripes with shadows and highlights provide said icon with a three-dimensional appearance".

The Examiner further asserts that according to Smith et al., users may edit the bits of an icon bitmap using an editing-an-icon feature, which includes draw button 1012 and eraser button 1011 for turning on or off each bit of the icon simply by touching each block of icon shown in icon editing screen 1010, in order to create a new icon or modify an existing one so as to draw attention to or highlight/emphasize an icon for a three-dimensional appearance, i.e. to have or appear to have extension in depth, such as depicted by icon 1014, an icon having the appearance of depth and a resultant of a combination of light and dark stripes as well as shadows/darkened areas and highlights/emphasis).

The Examiner admits that, although Smith's invention is not limited to the picture of the graphical icon depicted in fig. 10, Smith does not explicitly disclose creating a graphical icon

of a selected stripe of said light and dark stripes changes from dark to light and remains light in a region bordering on at least a part of a light segment in said neighboring stripe or in a further neighboring stripe, and beyond said light segment said selected stripe remains light or changes back to dark to create a highlight adjacent to said edge or another edge of said icon.

Furthermore, the Examiner alleges that MS Excel teaches a selected stripe of said light and dark stripes changes from light (fig. 2; *from left to right, column/stripe 32 of the briefcase icon edge*) to dark (fig.2; *stripe 31*) and remains dark in a region bordering on at least a part of a dark segment of a neighboring stripe (fig. 2; *stripe 30*) and beyond said dark segment said selected stripe remains dark or changes back to light to create a shadow adjacent to an edge of said icon (fig. 2; *stripe 29 is the changed light stripe; the whole effect is one of a shadow adjacent to the edge of the briefcase icon*), and a selected stripe of said light and dark stripes changes from dark (fig. 2; *stripe 9*) to light (fig. 2; *stripe 10*) and remains light (fig. 2; *stripe 11*) in a region bordering on at least a part of a light segment in said neighboring stripe or in a further neighboring stripe, and beyond said light segment said selected stripe remains light or changes back to dark to create a highlight (fig. 2; *stripe 12 is the changed dark stripe; the alternating dark, light, light and dark striped sequence causing a highlight effect*) adjacent to said edge or another edge of said icon (figs. 1 (A-B) and 2; *Smith's method of creating an icon was applied in forming icons 110, 120 and 130 of figs. 1(A-B) and scaled version of 110 and 120 in fig. 2 in order to demonstrate the scope of creating an icon bit by bit or in this instance, cell by cell*)).

Regarding independent claim 1, the Examiner's arguments are confusing, mathematically incorrect and do not follow the MPEP guidelines. Thus, the Examiner's interpretation of the description of Smith et al. patent and MS Excel needs further clarification in order to distinguish the present invention from these references.

MPEP paragraph 2143 states:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Regarding independent claim 1 of the present invention, the Examiner does not show that the references she quoted contain all the claim limitations as required by the third criterion (prior art references when combined must teach or suggest all the claim limitations) of the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

First, the Examiner's arguments are somewhat confusing. The Examiner states that Smith et al. teach "A computer-readable medium encoded with a data structure for use in providing a graphical icon for display on a display of a portable communications device, characterized in that said data structure is encoded as digital data indicative of said graphical icon defined by alternating light and dark stripes, that selected stripes of said light and dark stripes change from light to dark and back to light to indicate a shadow adjacent an edge of said icon and from dark to light and back to dark to indicate a highlight adjacent another edge of said icon, and that altogether said light and dark stripes with shadows and highlights provide said icon with a three-dimensional appearance." Actually the Examiner quotes here the first claim before the AMENDMENT WITH REQUEST FOR CONTINUED EXAMINATION was submitted to the USPTO on November 29, 2004, which is not under consideration here.

Moreover, The Examiner emphasizes the role of the erasure button 1011 and the draw button 1012 described by Smith et al. and referring to so-called "Smith et al.'s method" for creating

an icon. It is self-evident that any bitmap screen will have such means (e.g., erasure button 1011 and draw button 1012 and others) and so-called "Smith et al.'s method" for creating an icon by relying on such means as described by Smith et al. (col. 7, line 50 through col. 8, line 10) has nothing to do with the present invention, i.e., describing a methodology for designing 3-dimensional icons and therefore, Smith et al. does not teach the embodiments of independent claim 1 (in the original form or after amending it) of the present invention.

Anyway, regardless if there is any relevance to the present claim 1 or not, the Applicant disagrees with the Examiner's arguments and confirms again the considerations presented in the REQUEST FOR CONSIDERATION filed on September 24, 2003, presented in the Reply Brief mailed to the Patent Office on November 10, 2004, presented in the Appeal Brief filed on May 27, 2004, as well as presented in the request for reconsideration filed May 16, 2005. The main points are summarized below.

**First,** a house contour of the icon (bitmap view 1014) shown in Figure 10 of Smith et al. have a strict two-dimensional line structure with a two-dimensional outline which does not create a three-dimensional appearance (no depth perception) whatsoever, contrary to what is recited in claim 1 of the present invention, thus not meeting the requirements of the MPEP Rule 2143 quoted above. When confronted with the question regarding 3-dimensionality of Figure 10 of Smith et al. during a telephone interview on September 9, 2005, the Examiner Kristine Kinkaid did not provide any comprehensive answer.

**Second,** the bitmap view 1014 shown in Figure 10 of Smith et al. do not have alternating light and dark stripes defined in claim 1 of the present invention. All stripes of Smith et al. originally (i.e., when icon does not contain any picture) are, e.g., light, wherein thin dark grid lines are shown only for visualization of separation between light pixels. When a certain

picture is to be drawn in the bitmap view 1014 (e.g., by using the draw button 1012), selected light pixels are converted to dark thus identifying the image of the depicted picture. Consequently, Smith et al. do not have alternating light and dark stripes defining any icon as recited in claim 1 of the present invention, thus not meeting the requirements of the MPEP Rule 2131 quoted above.

Regarding alternating light and dark stripes, Examiner Kristine Kinkaid pointed out during the telephone interview on September 9, 2005 that, e.g., the dark line indicating the bottom of the house in figure 10 of Smith et al. can be interpreted as an alternating dark line per claim 1 of the present invention. The dark line in Figure 10 referred to by Examiner Kinkaid is a shadow outlining the edge of the icon picture (a house), therefore it cannot be interpreted in the frame of claim 1 of the present invention as both the edge (shadow) outlining the icon edge and the alternating dark stripe: it is either one or another.

**Third,** Smith et al. show (but not even teach in the text as mentioned above) in Figure 10 a situation when a row of pixels changes pixels from light to dark and back to light to indicate a shadow (adjacent to an edge) of said icon. It is clear from claim 1 that "edge" means any edge identifying a feature of the icon as supported by the disclosure (specification) of the present invention, for instance at page 3, line 14 and not an "edge" of the boundary of the icon, as alleged by the Examiner (see Advisory Action of April 5, 2005). Rather, as recited in claim 1, the shadows and highlights with alternating dark and light stripes provide the icon with a three-dimensional appearance. However, Smith et al. not only did not show alternating dark and light stripes but also did show in Figure 10 the second situation recited by the independent claim 1 of the present invention when the stripes change from dark to light

and back to dark to indicate a highlight adjacent another edge of said icon. This is because (as mentioned above) all stripes of Smith et al. originally are presumably light and Smith et al. use only dark pixels to depict the two-dimensional lines defining the house-icon and do not have any need to go from dark to light and then to dark again to indicate a highlight adjacent another edge within said icon. Smith et al. do not show both shadows and highlights adjacent to the edges of the icon in Figure 10 which is the essence of claim 1 of the present invention, *thus not meeting the requirements of the MPEP Rule 2143 quoted above.* It is the alternating light and dark striped structure of the claimed icon that makes it possible to create the highlights and shadows that give the icon its three-dimensional appearance. See the present disclosure at page 5, lines 1-2 following the detailed description on page 4, lines 18-34 of Figure 2E that details how the stripes can be changed to create the effect.

Regarding highlights and shadows discussed above, during the telephone interview on September 9, 2005, both Examiners Le Hguyen and Kristine Kinkaid confirmed (e.g., see Office Communication 9/13/2004, page 6, last paragraph or Office communication of 4/5/2004, 2<sup>nd</sup> and 3<sup>rd</sup> lines of the last paragraph) that according to the "rules of mathematics" when the line length goes to zero it becomes a point but still can be regarded as a line. Furthermore, the Examiner uses this "new rule of mathematics" to prove the formation of highlights and shadows in figure 10 of Smith et al. as discussed in more detail in the Office Communication 9/13/2004, page 6, last paragraph and in the Office communication of 4/5/2004, last paragraph, and the Examiner's arguments are based on that assumption in rejecting claim 1. Indeed, the line becomes a point when its length goes to zero but it cannot be regarded as a line when its length goes to zero: it becomes a point (the line is defined by

at least two points). The applicant attaches several pages of definitions of a line and a point from Wikipedia and nothing indicates there that a point can be interpreted as a line. The Applicant challenges the Examiners to provide an alternative definition in any written reputable publication they could not refer to during the telephone interview of September 9, 2005. In other words, a single pixel of Smith et al. cannot be interpreted as a line, therefore the Examiner's arguments based on that assumption are wrong.

If Figure 10 of Smith et al. is compared with images of Figures 2A through 2F of the present invention, it can be easily noticed that a) there are no alternating light and dark stripes through the icon (required by claim 1), b) the house contour of the icon in Figure 10 of Smith et al. is shown using only dark lines, which does not create said three-dimensional appearance, whereas the stripes shown in Figures 2A through 2F of the present invention are shown creating a combination of both dark and light edges as "shadows" and "highlights" which provide the three-dimensional appearance recited in claim 1 of the present invention. These are the fundamental differences between the present invention recited in claim 1 and Smith et al. and c) there is no 3-dimensional appearance in Figure 10 of Smith, et al.

Even if, in regard to independent claim 1, for the sake of argument only, we consider that the Examiner's arguments above are correct (which is not true as stated above), the Examiner's reference to the "former" claim 1 is irrelevant because the amended claim 1 differs significantly from the claim 1 before the AMENDMENT WITH REQUEST FOR CONTINUED EXAMINATION file on November 29, 2004. Therefore, it is confusing what features of claim 1 (after it is amended and is considered here) are described by Smith et al. and which are not described by Smith et al. The Applicant concludes that based on the above



considerations, the Examiner does not show any relevance of Smith et al. to claim 1 (in the original or amended form) of the present invention.

Furthermore, the Examiner stated that MS Excel teaches (which is not taught by Smith et al. as admitted by the Examiner) "a selected stripe of said light and dark stripes changes from light to dark and remains dark in a region bordering on at least a part of a dark segment of a neighbouring stripe, and beyond said dark segment said selected stripe remains dark or changes back to light to create a shadow adjacent to an edge of said icon, ...". The Applicant does not see any connection with MS Excel (which is a spread sheet software), as alleged by the Examiner, and the Examiner does not provide any detail or even a hint regarding this connection.

It is further confusing that the Examiner uses reference to Smith et al. when discussing how MS Excel (see the quote above from the Official Action of 8/10, 2005, pages 3 and 4) described the "part" of claim 1 not covered by Smith et al. in the above quote. Moreover, reference to Figures 1a, 1b and 2 which are not a part of the patent application but arbitrarily generated (by copying several Figures from the original patent application) by the Examiner and, e.g., included in the Office Communication of March 19, 2005, is confusing. Figures 1a, 1b and 2 generated and presented by the Examiner do not prove the point which the Examiner is trying to make and are irrelevant to the present invention. Of course, images presented in Figures 1 and 2A through 2F of the present invention can be somewhat copied (though a "copy" is always not as good as the original) using the bitmap view 1014 shown by Smith et al. in Figure 10 by using said buttons 1011 and 1012 of Smith et al. That is not the issue here. The question is not that the Figures 1 and 2A through 2F of the present invention can be (approximately) reproduced using Smith et al. bitmap of Figure 10. That is obvious because

Figures 1 and 2A through 2F are comprised of pixels and therefore naturally a bitmap grid can reproduce these images. The question is whether Smith et al. teaches principles and algorithms for generating images shown in Figures 1 and 2A through 2F of the present invention which is taught by independent claim 1 of the present invention and further taught by other claims. In that regard the Examiner repeated the same arguments which were extensively rebutted above and did not present any further reasonable explanations on how Smith et al. teaches the embodiments of claim 1 of the present invention.

Summarizing, it is overwhelming that Smith et al. and MS Excel (separately or in combination) do not describe many claim limitations of claim 1 (as amended by the AMENDMENT WITH REQUEST FOR CONTINUED EXAMINATION submitted to the USPTO on November 29, 2004), as alleged by the Examiner, thus failing to meet the third criterion of MPEP paragraph 2143 quoted above.

Even if only for the sake of argument we assume that Smith et al. and MS Excel, when combined, teach or suggest all the limitations of independent claim 1, there is no suggested desirability or motivation, expressed explicitly, implicitly or even hinted at by Smith et al., MS Excel or generally available to one of ordinary skill in the art to modify the references or to combine reference teachings to arrive at the subject matter of claim 1 of the present invention (as required by the MPEP Paragraph 2143 referenced above and by the case law). The Federal Circuit Court has several times expressly addressed the issue.

For example, in *In re Geiger, supra*, it is stated, in holding that the USPTO "failed to establish a *prima facie* case of obviousness":

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the

combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)."

Furthermore, Judge Newman, in her opinion in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed Cir. 2002), repeats this fundamental principle:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

There is no suggested desirability or motivation, expressed explicitly, implicitly or even hinted at by either Smith et al., MS Excel or generally available to one of ordinary skill in the art (as required by the MEMP Paragraph 2143 and the case law based criteria referenced above) to modify the references or to combine reference teachings to enable claim 1. None of the references quoted by the Examiner suggests, discusses or even hints about the solution recited in claim 1 of the present invention. Smith et al. teach improving of scrolling capabilities with automatic compression and expansion of the display during the scroll. MS Excel is a spread sheet software, digitally based, for creating graphs and it is similar to many other software packages. None of the references quoted by the Examiner discusses or hints about creating 3-dimentional images, recited in claim 1 of the present invention.

In other words the Examiner failed to show prima facie case of obviousness because he does not show any basis even remotely present in the art at the time of the invention for combining or modifying references (see MPEP paragraphs 2142, 2143 quoted above, and the case law). Therefore, it is highly unlikely that somebody of ordinary skill in the art would

have been reasonably expected to combine references quoted by the Examiner at the time of the invention and to find the solution claimed by the Applicant without the benefit of hindsight (again assuming for sake of argument only that Smith et al. and MS Excel, when combined, teach or suggest all the limitations of independent claim 1).

Moreover, Smith et al. and MS Excel do not provide teaching or suggestion for the reasonable expectation of success by combining their teaching, as required by the MPEP paragraph 2143, quoted above to establish a *prima facie* case of obviousness.

Thus, based on the above remarks, claim 1 is not obvious under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of MS Excel.

B. CLAIMS 5 AND 9 ARE NOT OBVIOUS UNDER 35 USC SECTION 103(a)

Claims 5 and 9 are rejected under 35 USC 103(a) as being unpatentable over Smith et al. (US Patent No. 5,923,327) in view of Screen Dumps of Microsoft Excel 2000 ("MS Excel") on page 2 of the Final Office Action mailed on August 10, 2005.

Claims 5 and 9 are independent apparatus and method claims, which are similar in scope to claim 1 of the present invention. Therefore, arguments made in Section VIII.A above regarding novelty and non-obviousness of independent claim 1 are fully applied to claims 5 and 9 of the present invention. Therefore, claims 5 and 9 are not obvious under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of MS Excel as well.

C. CLAIMS 2, 6, 10 and 13-15 ARE NOT OBVIOUS UNDER 35 USC SECTION 103(a)

Claims 2, 6, 10 and 13-15 are rejected under 35 USC 103(a) as being unpatentable over Smith et al. (US Patent No.

5,923,327) in view of Screen Dumps of Microsoft Excel 2000 ("MS Excel") on page 2 of the Final Office Action mailed on August 10, 2005.

Claims 2, 6, 10 and 13-15 are dependent claims of independent claims 1, 5 and 9, respectively. Since independent claims 1, 5 and 9 are not unpatentable over Smith et al. in view of MS Excel under 35 USC Section 103(a), as shown above, dependent claims 2, 6, 10 and 13-15 referred to corresponding novel independent claims 1, 5 and 9 are also novel, and, therefore, they are not obvious under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of MS Excel as well.

D. CLAIMS 3-4, 7-8 and 11-12 ARE NOT OBVIOUS UNDER 35 USC SECTION 103(a)

Claims 3-4, 7-8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US Patent No. 5,923,327) in view of Screen Dumps of Microsoft Excel 2000 ("MS Excel"), as applied to claims 1, 5 and 9, respectively, and further in view of Hess et al. (US Patent No. 6,415,320) on page 5 of the Final Office Action mailed on August 10, 2005.

The Examiner alleges regarding claims 3 and 4 (the same is applied to claims 7-8 and 11-12), that "Smith et al. teach a computer-readable medium characterized in that the data structure is encoded according to a Portable Bitmap file format (col. 7, line 61). Although Smith et al. do not explicitly disclose the file format to be in a Portable Greymap file format or a portable color image file format/Portable Pixmap, Hess et al. teach a computer-readable medium characterized in that the data structure is enclosed in various file formats, including Portable Bitmap file format, Portable Greymap file format and a Portable Pixmap (col. 8, lines 31-34; PBM/PGM/PPM). Therefore, it would have been obvious to an artisan at the time of the invention to include Hess' teachings of a computer-readable

medium characterized in that the data structure is encoded in various file formats, including Portable Bitmap file format in order to contribute to the flexibility of saving images in various file formats and providing an additional convenience to the users, especially given that all of these formats are art equivalent."

The applicant respectfully disagrees with the Examiner's argumentation.

First, claims 3-4, 7-8 and 11-12 are dependent claims of independent claims 1, 5 or 9, respectively. Independent claims 1, 5, and 9 are not obvious over Smith et al. in view of MS Excel, as shown above in Section VIII.A, or over Smith et al. in view of MS Excel, as applied to claims 1, 5 and 9, respectively, and further in view of Hess et al. Since each of the dependent claims 3-4, 7-8 and 11-12 narrows the scope of novel and non-obvious independent claims 1, 5, or 9, non-obviousness of claims 11, 5 or 9 will compel non-obviousness of claims 3-4, 7-8 and 11-12. Therefore, claims 3-4, 7-8 and 11-12 are not obvious over Smith et al. in view of MS Excel, as applied to claims 1, 5 and 9, respectively, and further in view of Hess et al. under 35 USC 103(a).

Another way to rebut the 35 U.S.C. 103(a) rejection of claims 3-4, 7-8 and 11-12 is by analyzing MPEP guidelines which are stated in the MPEP Paragraph 2143 quoted above.

Furthermore, according to the case law and accepted practice of the US patent office there are several criteria which should be applied in determining obviousness, where the rejection is made under 35 U.S.C. 103. These criteria based on the case law are summarized below.

1. When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the

references. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586 (Fed. Cir.) cert. denied, 530 U.S. 1238 (2000). In addition, court requires the Patent and Trademark Office to make specific findings on a suggestion to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 1 (Fed. Cir. 1999).

2. The Federal Circuit instructs that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).
3. The Federal Circuit reasons in *Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.*, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), *cert denied*, 519 U.S. 822 (1996) that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Applicant. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." *Para-Ordnance*, 73 F.3d at 1087, 37 USPQ2d at 1239, *citing W. L. Gore & Assocs., Inc v. Garlock Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 Fed. Cir 1983), *cert. denied*, 469 u.s. 851 (1984).

First, Smith et al., MS Excel, and Hess et al. do not teach or suggest all the limitations of dependent claims 3-4, 7-8 and

11-12 based on the arguments presented in Section VIII.A, as required by the MPEP Paragraph 2143 to establish a *prima facie* case of obviousness. Indeed, as shown above in Section VIII.A, Smith et al. and MS Excel do not describe all claim limitations (e.g., having alternating light and dark stripes, shadows and highlights, etc.) of the independent claims 1, 5 and 9 as contrary to what is alleged by the Examiner. This means that the same limitations are not described by Smith et al., by MS Excel or by Hess et al. in regard to dependent claims 3-4, 7-8 and 11-12. Furthermore, Hess et al. indeed talk (col. 8, lines 46-47) about portable graymap file format which is recited in claims 3, 7 and 11 of the present invention. However, Hess et al. do not describe a portable color image file format, recited in claims 4, 8 and 12 of the present invention, because the Portable Pixmap described by Hess et al. is not the same as the portable color image file format as alleged by the Examiner.

Second, even if for the sake of argument only we assume that Smith et al., MS Excel and Hess et al. teach or suggest all the limitations of dependent claims 3-4, 7-8 and 11-12, there is no suggested desirability or motivation, expressed explicitly, implicitly or even hinted at by either Smith et al., MS Excel or by Hess et al., or generally available to one of ordinary skill in the art (as required by the MPEP Paragraph 2143 and the case law based criteria referenced above) at the time of the invention to modify the references or to combine reference teachings to arrive at the subject matter of claims 3-4, 7-8 and 11-12 of the present invention. In other words, Hess et al. teach information presentation and management in an online trading environment which has nothing to do with three-dimensional icons for graphical user interfaces. Therefore, it is highly unlikely that somebody of ordinary skill in the art would have been reasonably expected to find the solution claimed by the Applicant without the benefit of hindsight (also as



required by the MPEP paragraph 2143 and the case law referenced above).

Thus based on the above arguments, claims 3-4, 7-8 and 11-12 are not obvious under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of MS Excel, as applied to claims 1, 5 and 9, respectively, and further in view of Hess et al.

It is respectfully noted that the objections and rejections of the Official Action of August 10, 2005 have been shown to be inapplicable, reversal thereof is requested, and passage of the claims 1-15 to issue is solicited.

IX. CONCLUSION

For all of the aforementioned reasons, it is respectfully submitted that the rejections of all the claims in the application, namely claims 1-15, are in error, and the rejections should be reversed. Early allowance of all the claims in the application is earnestly solicited.

Respectfully submitted,



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11/21/05

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X. APPENDIX--THE CLAIMS INVOLVED IN THE APPEAL

1. (Previously Presented) A computer-readable medium encoded with a data structure for use in providing a graphical icon for display on a display of a portable communications device, characterized in that said data structure is encoded as digital data indicative of said graphical icon defined by alternating light and dark stripes, that a selected stripe of said light and dark stripes changes from light to dark and remains dark in a region bordering on at least a part of a dark segment of a neighbouring stripe, and beyond said dark segment said selected stripe remains dark or changes back to light to create a shadow adjacent to an edge of said icon, and a further selected stripe of said light and dark stripes changes from dark to light and remains light in a region bordering on at least a part of a light segment in said neighbouring stripe or in a further neighbouring stripe, and beyond said light segment said selected stripe remains light or changes back to dark to create a highlight adjacent to said edge or another edge of said icon, and that altogether said light and dark stripes with shadows and highlights provide said icon with a three-dimensional appearance.

2. (Original) The computer-readable medium of claim 1, characterized in that said data structure is encoded according to a portable bitmap file format.

3. (Original) The computer-readable medium of claim 1, characterized in that said data structure is encoded according to a portable graymap file format.

4. (Original) The computer-readable medium of claim 1, characterized in that said data structure is encoded according

to a portable color image file format.

5. (Previously Presented) A communication device, comprising:  
means, responsive to an event in the communication device,  
for providing an event signal;

a computer-readable medium encoded with a data structure  
for use in providing a graphical icon for display on a display  
of a portable communications device, wherein said data structure  
is encoded as digital data indicative of said graphical icon  
defined by alternating light and dark stripes, that a selected  
stripe of said light and dark stripes changes from light to dark  
and remains dark in a region bordering on at least a part of a  
dark segment of a neighbouring stripe, and beyond said dark  
segment said selected stripe remains dark or changes back to  
light to create a shadow adjacent to an edge of said icon, and a  
further selected stripe of said light and dark stripes changes  
from dark to light and remains light in a region bordering on at  
least a part of a light segment in said neighbouring stripe or  
in a further neighbouring stripe, and beyond said light segment  
said selected stripe remains light or changes back to dark to  
create a highlight adjacent said edge or another edge of said  
icon, and that altogether said light and dark stripes with  
shadows and highlights provide said icon with a three-  
dimensional appearance; and

means, responsive to the event signal, for retrieving the  
digital data from the computer-readable medium and causing said  
display of said graphical icon on said display according to said  
retrieved digital data.

6. (Original) The device of claim 5, wherein said data is  
encoded according to a portable bitmap file format.

7. (Previously Presented) The device of claim 5, characterized

in that said data structure is encoded according to a portable graymap file format.

8. (Previously Presented) The device of claim 5, characterized in that said data structure is encoded according to a portable color image file format.

9. (Previously Presented) Method of displaying an icon on a portable communication device, comprising the steps of:

retrieving, in response to an event signal, digital data from a computer-readable medium, wherein said digital data is indicative of said icon defined by alternating light and dark stripes, that a selected stripe of said light and dark stripes changes from light to dark and remains dark in a region bordering on at least a part of a dark segment of a neighbouring stripe, and beyond said dark segment said selected stripe remains dark or changes back to light to create a shadow adjacent to an edge of said icon, and a further selected stripe of said light and dark stripes changes from dark to light and remains light in a region bordering on at least a part of a light segment in said neighbouring stripe or in a further neighbouring stripe, and beyond said light segment said selected stripe remains light or changes back to dark to create a highlight adjacent to said edge or another edge of said icon, and that altogether said light and dark stripes with shadows and highlights provide said icon with a three-dimensional appearance; and

displaying said icon in response to said digital data.

10. (Original) The method of claim 9, wherein said digital data is encoded according to a portable bitmap file format.

11. (Original) The method of claim 9, wherein said digital data

is encoded according to a portable graymap file format.

12. (Original) The method of claim 9, wherein said digital data is encoded according to a portable color image file format.

13. (Previously Presented) The computer-readable medium of claim 1, wherein said alternating light and dark stripes are vertical.

14. (Previously Presented) The device of claim 5, wherein said alternating light and dark stripes are vertical.

15. (Previously Presented) The method of claim 9, wherein said alternating light and dark stripes are vertical.